

Appl. No. 10/727,457  
Atty. Docket No. 8601MC  
Reply dated 12/14/2004  
Not of Non-Compliance dated 12/02/2004  
Customer No. 27752

### REMARKS

Claims 1-6, 8, and 10-21 are pending in the present application. No additional claims fee is believed to be due.

Claims 7 and 9 have been cancelled without prejudice.

Claims 1-3, 8, 14, 16, 17 and 21 have been amended to correct minor grammatical errors.

Claims 1 and 21 have been amended to include limitations to the flow control layer and to the fluid control layer. Antecedent basis for these amendments is found on page 2, lines 15-17 and on page 10, lines 1-3 of the specification.

Claims 13 and 15 have been amended exclude references to the location of the skin and hand contact layers. Antecedent basis for this amendment is found on page 2, lines 25-31 of the specification, where Applicants believe the terms skin contact layer and hand contact layer both are clearly defined.

Claims 14 and 16 have been amended to read "wherein the skin contact layer comprises material selected from the group consisting of ... ." Antecedent basis for this amendment is found on page 2, lines 28-29 of the specification. Claims 14 and 16 also have been amended to correct typographical mistakes regarding the term "synthetic." Support for this amendment is found at page 5, line 7 of the specification.

It is believed these changes involve no introduction of new matter. Consequently, entry of these changes is believed to be in order and is respectfully requested.

#### I. Objections to Disclosure

The Office Action objects to informalities in the specification, namely, that the title is in bold type, and that the section headings and examples use underlining. The Office Action cites 37 CFR 1.77(b) in support of these objections: "Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading."

Applicants respectfully point out that the language of 37 CFR 1.77(b) does not require the use of this formatting. Rather, the statute suggests that each of the items *should* be formatted as such. Applicants have amended the specification in accordance

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with the Office Action's request that the bold type and underlining be removed from the title, and that the underlining be removed from the section headings. Applicants have not amended the specification to remove the underlining from the examples. Applicants assert that this formatting is preferable to facilitate reading of the application, and furthermore that this formatting is not prohibited by the cited statute. Applicants respectfully request that this requirement be reconsidered and withdrawn.

The Office Action asserts in paragraph 7 (V) that on page 15, in lines 1 and 5, the description of element (356) is inconsistent. Applicants point out that in both instances, element (356) refers to a layer, and that the specification sufficiently indicates that this is the same layer. Applicants also assert, however, that this is further clarified in light of the amended drawings included herein.

The Office Action asserts in paragraph 7 (W) that only Reissue applications are permitted to use italics. Applicants respectfully traverse. Applicants have diligently searched the relevant sections of the MPEP, including Chapter 600, 37 CFR 1.52 (Language, paper, writing, margins.), 37 CFR 1.77 (quoted above) and have failed to locate this requirement. Applicants further point out that the use of italics is proper when citing a reference or when referring to a genus and species, and that this formatting regularly appears in issued patents. Applicants therefore respectfully request that Examiner either indicate to Applicants the relevant sections of the MPEP so that Applicants may fully comply with its requirements, or to reconsider and withdraw this objection.

The Office Action asserts in paragraph 7 (BB) that on page 25, line 19, the meaning of "O/W" should be clarified. Applicants point out that this term is used in a citation of a reference, and that literal reproduction of the title is required. Applicants therefore assert that clarification would be improper. Furthermore, the specification thereafter states "Preferred compositions herein are oil-in-water emulsions," which Applicants assert sufficiently clarifies this term.

The Office Action asserts in paragraph 7 (CC) that the term "RV" on page 25, line 23 requires clarification. Applicants point out that this term designates the name of the instrument that was used (a Brookfield DVII RV viscometer). Similarly, Applicants submit that the term "TD," or as used herein, "spindle TD," refers to the manufacturer's designation of the spindle. The meaning of these terms, if any, is known by the manufacturer and would be known or readily available to those skilled in the art.

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Applicants have amended the specification and made an earnest effort to comply with the Office Action's requirements. In light of these amendments and explanations, Applicants respectfully request that the objections to the specification be reconsidered and withdrawn.

## II. Rejection Under 35 U.S.C. 112 First Paragraph

Claims 8 and 9 have been rejected under 35 U.S.C. 112, first paragraph, as failing to be enabled by the specification. Applicants have amended the specification as indicated above to read "batting, sponge, foam, and combinations thereof." Antecedent basis for this amendment is found in the original claims, in accordance with MPEP 2163.03 (*In re Koller*, 613 F.2d 819, 204 USPQ 702 (CCPA 1980)). Based on this amendment, Applicants respectfully request reconsideration and withdrawal of this rejection.

Claims 7, 8 and 13-16 have been rejected under 35 U.S.C. 112, second paragraph, as failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 7 has been cancelled. In light of the amendment to Claim 8, Applicants respectfully request reconsideration and withdrawal of this amendment. Claims 13 and 15 have been amended to delete the phrase "located on the opposite side of the flow control layer to the fluid storage layer." In Claim 13, this limitation refers to the skin contact layer, whereas in Claim 15, this limitation refers to the hand contact layer. Applicants believe that the terms skin contact layer and hand contact layer both are clearly defined in the specification, and have been further clarified in the amended drawings submitted herewith. Applicants therefore respectfully request reconsideration and withdrawal of this rejection.

The Office Action rejects Claim 14, asserting that the limitation "the skin contact layer material" lacks sufficient antecedent basis. Similarly, the Office Action rejects Claim 16, asserting that the limitation "the hand contact layer material" lacks sufficient antecedent basis. Claims 14 and 16 have been amended to read "wherein the skin contact layer comprises material selected from the group consisting of ... ." Proper antecedent basis for "the skin contact layer" is found in Claim 13, and for "the hand contact layer" is found in Claim 15. In light of these amendments, Applicants respectfully request reconsideration and withdrawal of these rejections.

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**III. Rejection Under 35 USC 103(a) Over Fields et al. (WO 01/26528 A1) in view of D'Alessio et al. (US 6,283,933).**

The Office Action rejects Claims 1-8 and 10-21 under 35 U.S.C. 103(a) as being unpatentable over Fields et al. (WO 01/26528 A1) (hereinafter "Fields") in view of D'Alessio et al. (US 6,283,933) (hereinafter "D'Alessio"), in further view of Rabenecker et al (US 6,129,894, hereinafter "Rabenecker"). The present invention teaches an applicator suitable for distributing cosmetic compositions to the hair or skin, comprising a flow control layer, a fluid storage layer, and a fluid impermeable layer, which prevents contact of the applicator contents with the skin. Fields teaches an applicator suitable for distributing substances onto a surface, the most preferred embodiment being a mitt or glove. D'Alessio teaches an applicator containing an ampule or vial capable of containing from 0.6 to 10 ml, suitable for administration of biomedical fluids. Rabenecker teaches a syringe-like device, suitable for taking multiple swab samples. The Office Action concludes that it would have been obvious to one of ordinary skill in the art to combine these references to produce all aspects the present invention. Applicants respectfully traverse this rejection, and assert that the Office Action has failed to establish a *prima facie* case of obviousness.

According to *In re Vaeck*, 20 USPQ2d 1438:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

**a. The cited art fails to teach or suggest all the claim limitations.**

Fields teaches a flow control layer (or "flow restriction layer") made from materials such as non-wovens, wovens, apetured films, and thermoformed films, which have varying porosity and thus a varying flow rate. One example of material used in the flow control layer is TYVEK™. See Fields, p. 15, lines 9-14. With TYVEK, the "pore size" is controlled by the fiber size, layering and density of fibers. Thus, whereas it is possible to control to some extent the "pore size," there may be a wide range of porosity in any one material. The present invention, however, teaches that the flow control layer preferably utilizes a cloth-like formed film ("CLIFF") with 1% ATMER™ anti-static

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agent and 0.8 gsm Si coating. See page 2, lines 15-17 of the specification. CLIFF films have actual pores, and can be made to produce a more exact pore size, and thus less variance within a given material, than is possible with TYVEK. This allows for a more precise control of the flow. In addition, application of the silicon coating allows for control of the surface hydrophobicity. Silicon coatings typically make the CLIFF material more hydrophobic and therefore more resistant to water-based formulas.

Instant claims 1 and 21 have been amended to include the elements of a cloth-like formed film and a silicon coating. Because none of the cited art teaches the use of such material in a flow control layer, Applicants assert that the criteria of *In re Vaeck*, requiring the prior art references to teach or suggest all of the claim limitations, has not been met. Applicants therefore request that the rejection of Claims 1 and 21, and of dependent claims 2-6, 8, and 10-20, be reconsidered and withdrawn.

**b. The Office Action establishes no motivation to combine the cited references.**

Instant claims 1 and 21 have been amended to include that the fluid storage layer comprises batting, which in turn comprises viscose. The Office Action states that, although Fields fails to disclose that the fluid storage layer comprises viscose fibers, Rabenecker teaches a fluid storage layer comprised of absorbent foam or viscose fibers.

A reference is not available under 35 U.S.C. §103 if it is not within the field of the inventor's endeavor and was not directly pertinent to the particular problem with which the inventor was involved. *King Instrument Corp. v. Otari Corp.* 767 F.2d 853, 226 U.S.P.Q. 402 (Fed. Cir. 1985).

The invention in Rabenecker concerns a syringe-type device, suitable for taking swab samples. In contrast, the present invention is an applicator, the function of which is to effectively store and dispense cosmetic compositions. One of skill in the art would not look to a device used for taking samples to solve problems associated with dispensing fluids, as the objective of the prior art is opposite to that of the present invention. The objective of the swab in Rabenecker is to effectively retain a sample, whereas the objective of the fluid storage layer is to dispense fluid, with as little retention as possible in order to avoid waste. Applicants therefore submit that the Office Action also fails to establish this criteria as set forth in *In re Vaeck*.

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c. *There could be no reasonable expectation of success.*

To establish a *prima facie* case of obviousness, the Office Action must establish that one of skill in the art would have a reasonable expectation of success in combining the cited references. Applicants reiterate the argument set forth above in reference to Rabenecker. The viscose referred to in Rabenecker is not used in a fluid storage device, but in fact may be present in a plug, which is used to take the swab samples. See Rabenecker, Column 1, lines 42-44 and Column 2, lines 20-22 and 24-28. Rabenecker states that viscose is suitable because it is porous and absorbent. The viscose utilized in the present invention effectively stores fluids, and, rather than being absorbent, has the advantage that "less of the fluid is irretrievably retained." See page 10, lines 4-6 of the specification. Applicants assert, therefore, that there is no indication in Rabenecker that viscose would be suitable in a fluid storage layer which, upon application, preferably retains as little of the stored fluid as possible.

In summary, Applicants point out that to establish a *prima facie* case of obviousness, each of the elements set forth in *In re Vaeck* must be established. The cited art fails to teach or suggest the amended claim element of a flow control layer comprising a cloth-like formed film having a silicon coating. In addition, the cited art fails to establish a motivation to combine the teaching of Rabenecker to produce a fluid storage layer comprising viscose. Finally, there could be no reasonable expectation of successfully combining the viscose fibers taught in Rabenecker with the fluid storage layer of the present invention. Therefore, Applicants assert that the Office Action fails to meet the burden required to establish a *prima facie* case of obviousness. Applicants therefore request that these rejections be reconsidered and withdrawn.

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Conclusion

In light of the above remarks, it is requested that the Examiner reconsider and withdraw the rejection under 103(a). Early and favorable action in the case is respectfully requested.

Applicants have made an earnest effort to place their application in proper form and to distinguish the invention as now claimed from the applied references. In view of the foregoing, Applicants respectfully request reconsideration of this application, entry of the amendments presented herein, and allowance of Claims 1-6, 8 and 10-21.

Respectfully submitted,

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